

Appl. No. 09/924,746
Amd. Dated July 19, 2005
Reply to Office Action of May 19, 2005

REMARKS/ARGUMENTS

Reconsideration of the present application, as amended under Rule 116, is respectfully requested.

Of claims 1, 3-7, 9-13 and 15-18 pending in this application, all were rejected. Claims 1, 6, 7, 12, 13 and 18 were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,894,362, which issued April 13, 1999 to H. Onaka *et al.*, in view of U.S. Patent No. 6,441,955, which issued August 27, 2002 to K. Takatsu *et al.* and European Patent Application No. EP 0981212 A1, which was published February 23, 2000 to F. Liden *et al.* Claims 3-5, 7, 9-11 and 15-17 were rejected under 35 U.S.C. §103(a) as being obvious over the cited Onaka patent in view of the cited Takatsu *et al.* patent and the cited Liden *et al.* application, and further in view of U.S. Patent Publication No. 2002/0048063 A1, which was published April 25, 2002 to Y.C. Jung *et al.*

In response to the applicant's previous arguments about the teachings of the Liden reference, the Examiner stated:

...Liden *et al.* disclose that the "amplifier" element is deliberately configured to attenuate signals and thereby may be functionally considered an attenuating element (column 5, lines 17-38; see also column 8, lines 10-12). The element attenuates power as desired by users in a fully operational mode....

To better make the distinction between amplifiers and optical attenuators, the applicants have amended independent claims 1, 7, and 13 so that term, "variable optical attenuator," appears in the claims. In such devices, the amount of signal attenuation can be controllably varied. On the other hand, the Liden pre-amplifier 15 requires that its optical pumping energy fall below a certain energy so that substantially all the light energy in the incoming optical signals will be absorbed and the signals attenuated rather than amplified. In this "glowing," nearly off state, the applicants do not see how the attenuation can be varied and controlled, as the term, variable optical attenuator, implies.

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The cited Takatsu reference does disclose the use of variable optical attenuators. However, this raises another troubling aspect in the combination of the cited Onaka, Takatsu and Liden references to reject the applicants' claims. As noted by the Examiner, "Takatsu et al. particularly suggest blocking only the signal having the undesired wavelength and do not specifically suggest blocking the composite WDM signal." On the other hand, "Liden et al. further teach that an attenuator (Figure 2, element 15) may be used to block further transmission of a composite WDM signal when a monitor has detected an abnormality on the path (column 5, lines 17-28; column 6, line 58; column 7, lines 1-3)." Nowhere is there an explanation of why one skilled in the art would make the combination, given the contradictory results of the Takatsu and Liden references. In other words, if the combination of the teachings of the Takatsu patent into the Onaka system yields a system which remains in operation even with an errant laser, why would one shut down the entire system, as taught by Liden et al.?

Hence the combination of the Onaka, Takatsu and Liden does not render amended independent claims 1, 7 and 13 obvious and these claims should be allowed. Furthermore, dependent claims 3-6, 8-12 and 15-18 should also be allowed for at least being dependent upon allowable base claims.

Therefore, for the amendments above and the remarks directed thereto, the applicants request that the rejections be withdrawn, that claims 1, 3-7, 9-13 and 15-18 be allowed and the case be passed to issue. If a telephone conference would in any way expedite the prosecution of the application, the Examiner is asked to call the undersigned at (408) 868-4088.

Respectfully submitted,


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